

REMARKS

The outstanding Official Action imposes a restriction requirement predicated upon the theory that the claims of the present application embodies five distinct and independent inventions.

The Official Action indicates that the first of these inventions, categorized as Group I, encompasses Claims 1 (part), 2, 5-6 (part) and 7-11 (part). These claims are directed to piperazine compounds, classified in Class 544, subclasses 224, 295, 360, 362, 367, 370, 392, 393, 394, 395 and others. The second invention, Group II, encompasses Claims 1 (part), 5 (part) and 7-11 (part), drawn to 4-membered rings, classified in Class 548, subclass 950. The third invention, denoted as Group III, includes Claims 1 (part) and 3-11 (part), drawn to 5-membered rings, classified in Class 548, subclasses 400, 402, 565, 577 and others. The fourth invention, Group IV, incorporates Claims 1 (part), and 3-11 (part). These claims are directed to 6-membered rings, classified in Class 546, subclasses 4, 192, 194, 199, 207-211, 213, 214, 230, 231, 233, 236-238 and others. Finally, the fifth invention, identified as Group V, encompasses Claims 1 (part), 5 (part) and 7-11 (part). These claims are directed to 7-membered rings, classified in Class 540, subclasses 596-599, 601-603 and 609-611.

The Official Action avers that the five inventions, Groups I to V, are structurally distinct based on the distinction in the heterocyclic ring, denoted as radical R₁. These rings vary in size and, in the case of Group I, the number of heteroatoms in the ring.

Applicants have elected Group I for prosecution on the merits in this application. However, applicants respectfully submit that the imposition of a restriction requirement in this case is inappropriate. Therefore, applicants traverse this requirement.

The question of the appropriateness of a restriction requirement is extensively discussed in the Manual of Patent Examining Procedure (MPEP) at §806. Therein a plurality of bases for the imposition of a restriction requirement predicated upon the absence of distinctiveness and independence are set forth. None of these grounds emulate the ground imposed in the outstanding Official Action.

The Official Action argues that the heterocyclic group of R₁, e.g. radicals II, III, IV and V, predicate distinctiveness. However, the ground advanced for the imposition in the outstanding Official Action is not within the contemplation of any of the grounds advanced in support of independence or distinctiveness in the MPEP, as set forth at §§806.04(a)-806.04(i) and 806.05(a)-806.05(i). As such, applicants respectfully submit that the ground for distinctiveness imposed in the outstanding Official Action is not sanctioned by the USPTO.

It is clear, on the contrary, that the claims of the present application are directed to a single generic class of compounds having the structural formula I. Indeed, the title of the present invention, naphthalene derivatives, emphasizes this fact.

For the above discussed reason, applicants submit that the restriction requirement is misplaced insofar as the basis for distinctiveness advanced in the Official Action does not apply to the claims of the present application.

The above remarks, which establish that the Official Action assertion of distinctiveness between the five sets of claims is not met, is buttressed by a second basis for removal of the provisional restriction requirement of record. That is, the statute, 35 C.F.R. §112, in its first sentence states:

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. (Emphasis added)

Pursuant to this statutory dictate, the implementing regulations of the Patent and Trademark Office include the mandate that restriction is appropriate only in cases presenting inventions which are both independent and distinct. 37 C.F.R. §§1.141 - 1.142. Without both independence and distinctiveness, a restriction requirement is not authorized.

In the present application the five sets of claims, which the Official Action has grouped as separate inventions, are not independent of each other so as to justify a restriction requirement. The claims of Group I, are drawn to a chemical compound. These claims cannot be considered "independent" of the claims of Group II-V, each drawn to the same generic chemical compound. Indeed, these five sets of claims are interrelated and interdependent.

The interdependence of the five allegedly independent sets of claims, set forth in the Official Action, is confirmed -- indeed it is mandated -- by virtue of the fact that the descriptive requirements of 35 C.F.R. §112 compel disclosure of all aspects of the five allegedly distinct and independent inventions of the present application. An application claiming a generic chemical compound must, of necessity, describe all meanings of the radicals included therein. The five sets of claims are thus clearly interdependent. Consequently, it is clear that all aspects of the present invention, including the products of Groups I to V, being interdependent, are not independent of each other. Thus, the above remarks provide yet further support for the proposition that the requirement for restriction in the present application is misplaced.

Applicants note that the instant restriction is supported by reference to different classes and subclasses of the Patent and Trademark Office classification system in which the

five groups of claims are classified. The inference that the classification of claims support a restriction requirement is submitted to be improper.

Reliance on a supposed classification of groups of claims does not establish independence and distinctiveness. The classification system has no statutory recognition with regard to whether inventions are independent and distinct. The sole purpose of the classification system is as an aid in identifying and searching for patents directed to the same general inventive entity.

The classification system is also an unreliable basis for requiring restriction between claims to various aspects of applicants' unitary invention because the Patent and Trademark Office classification system exhibits considerable overlap of technical definitions. In particular, the definition of classes and subclasses in the classification system does not prevent rejection of claims found in patent references classified in other classes or subclasses.

Furthermore, the classification system is a poor basis for restriction between related aspects of an invention insofar as classification definitions change over time. Thus, a classification that may have seemed to support restriction at a given time can change, thereby casting a shadow over the propriety of a restriction requirement later during the term of patents issued from parent and divisional applications. Indeed, classifications change in response to consideration of administrative convenience, often in response to nothing more than growth in the number of patents in a given class or subclass. These considerations have nothing to do with whether the subject matter of patents assigned to different classifications are "independent and distinct," as those terms are used in 35 C.F.R. §121, which fact proves that basing restriction requirements on the classification system is improper.

It is emphasized that the restriction requirement of record is not mandatory and is indeed contrary to the public interest. Courts have recognized that it is in the public interest to permit an applicant to claim all aspects of an invention in a single application, as applicants have done herein. The CCPA has observed:

We believe that the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe, in a manner required by 35 U.S.C. §112, all aspects as to what they regard as their invention, regardless of the number of statutory classes involved. In re Kuehl, 456 F.2d 658, 666, 117 USPQ 250, 256 (CCPA 1973).

This interest is consistent with the practical reality that a sufficiently detailed description supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application directed to other aspects of the invention.

Applicants respectfully suggest that in view of the continued increase in official fees and the resultant potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose of promoting and encouraging the progress of science and the useful arts.

It is vital that restriction requirements issue with only the proper statutory authorization because patents issuing on divisional applications, which are filed to prosecute claims that are held to be distinct and independent, can be vulnerable to legal challenge predicated upon the allegation of double patenting.

The third sentence of 35 U.S.C. §121, which states that a patent issuing on a patent application "shall not be used as a reference" against the divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that §121 protects a patentee from an

allegation of same invention double patenting. Studiengesellschaft Kohle mVP v. Northern Petrochemical Co., 784 F.2d 351, 355, 228 USPQ 837, 840 (Fed. Cir. 1986).

The same Court in Gerber Garment Technologies Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 USPQ2d 1436 (Fed. Cir. 1990) held that § 121 does not insulate a patentee from an allegation of “obviousness-type” double patenting and, in fact, the invalidation, on double patenting grounds, of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a Terminal Disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on a divisional application.

Although applicants have met the requirement that they elect the claims of one of the alleged inventions for prosecution on the merits, i.e. Group I, applicants submit that the above remarks establish the unitary nature of the claims of the present application which have been made subject to restriction. Reconsideration and removal of the provisional restriction requirement of record is thus deemed appropriate. Such action is respectfully urged.

Respectfully submitted,



Marvin Bressler
Registration No. 25,132
Attorney for Applicants

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, New York 11530
516-742-4343
MB:ml